

### REMARKS

Applicants note that the Patent Office has not required a shortened 3-month statutory period for a reply to the Office Action mailed April 8, 2003. Consequently, this reply is due by October 8, 2003.

Claim 1 has been amended to clarify that in the claimed protein microarrays, the protein or protein fragment forms a covalent bond, with the linker, via its terminus.

Claims 11-72, which were withdrawn from consideration, are now cancelled without prejudice. Applicants reserve the right to pursue claims directed to the subject matter of claims 11-72 in one or more divisional applications.

New dependent claims 73 and 74, which depend from claim 1, have been added. Support for these claims can be found throughout the specification, for example, on page 13, paragraph 1.

Claims 1-10 and 73-74 are pending in the application.

#### Rejection of Claims 1, 3, 4, 7, 9 and 10 under 35 U.S.C. §102(a)

Claims 1, 3, 4, 7, 9, and 10 were rejected under 35 U.S.C. §102(a), as being anticipated by MacBeath, *et al.*, *J. Am. Chem. Soc.*, 1999, 121:7967-7968 ("MacBeath").

At the outset, Applicants do not concede that MacBeath is prior art to the claimed invention. The Applicants reserve the right to establish an invention date for the claimed inventions that is on or before the date in 1999 when MacBeath became publicly available, which is the effect §102(a) date of MacBeath relied on by the Patent Office.

Moreover, MacBeath does not anticipate or render unpatentable the rejected claims, as asserted by the Patent Office in the Office Action. Although MacBeath teaches attaching a linker covalently to a glass surface, nowhere in MacBeath is a protein or protein fragment covalently bonded to a linker disclosed or suggested, let alone one protein or protein fragment having a terminus forming a covalent bond with a linker, as recited in claim 2. By contrast, in MacBeath, the proteins are attached to linkers through non-covalent interactions. For instance, MacBeath discloses biotin-streptavidin interactions and various antibody-protein interactions, none of which involve a covalent bond.

Accordingly, it is respectfully requested that the rejection of claim 1 be withdrawn. Claims 3, 4, 7, 9, and 10 depend on claim 1, and it is respectfully requested that the rejection of these claims be withdrawn as well for at least the above-mentioned reasons.

Rejection of Claims 2, 5, 6, and 8 under 35 U.S.C. §103(a)

Claims 2, 5, 6, and 8 were rejected under 35 U.S.C. §103(a), as being unpatentable over MacBeath in view of Wagner, et al., U.S. Patent No. 6,485,808 ("Wagner").

Claims 2, 5, 6, and 8 depend, either directly or indirectly, from claim 1. According to the Office Action, the basis for the rejection is that MacBeath teaches a system meeting all of the limitations of claim 1, except for the limitations added in claims 2, 5, 6, and 8. The Office Action states that Wagner discloses such limitations, and that it would be obvious to combine MacBeath with Wagner to add such additional features to the invention recited in claim 1.

For at least the reasons explained above with respect to the rejection under §102(a) in view of MacBeath, the foundation for the rejection under §103(a) (i.e., that MacBeath teaches all of the limitations of claim 1) is believed to be incorrect. Accordingly, while Applicants do not concede that there would have been any motivation to combine MacBeath and Wagner in the manner suggested in the Office Action, or that Wagner discloses or suggests any of the additional limitations of the claims rejected on the present basis, the present rejection cannot stand. Thus, withdrawal of the rejection of claims 2, 5, 6, and 8 is respectfully requested.

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Conf. No. 5833

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### CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,  
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Docket No. M0925.70106US00  
Date: September 8, 2003  
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